



Genotype
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Whatever Happened to the Enola Bean Patent Challenge?

On the shortest day of the year [in the North] – ETC Group provides a brief update on one of the longest-running patent challenges.

The Enola bean patent case demonstrates that intellectual property challenges are not a viable means of “correcting” abuses in the patent system. Just about everyone agrees that the Enola bean patent is technically invalid – the bean, in fact, is genetically identical to a pre-existing Mexican bean variety that was previously known and grown in the United States. The patent is also morally unacceptable because it is predatory on the knowledge and genetic resources of indigenous peoples and farming communities, who are the true innovators of Mexico’s yellow beans. The real crime is that, despite the legal challenge, the US patent system has allowed the patent owner to use bureaucratic delays and diversion to legally extend his exclusive monopoly on a bean variety of Mexican origin for over 6 years (and potentially more) – that’s nearly one third of the 20-year patent term. In essence, the system enables holders of unjust patents to monopolize markets and destroy competition – neither farmers nor firms can tread water for 6 years waiting for the outcome of a protracted patent challenge.

In recent years many people have inquired, whatever happened to the Enola bean patent challenge? Why has the US Patent & Trademark Office (US-PTO) taken so long to reach a decision? Here’s an update on the case:

Background: Almost six years ago, ETC Group (then RAFI) denounced the Enola bean patent as “Mexican bean biopiracy” and demanded that the patent be legally challenged and revoked. We requested that FAO and the Consultative Group on International Agricultural Research (CGIAR) investigate the patent as a likely violation of their 1994 Trust agreement that obliges them to keep designated crop germplasm in the public domain and off-limits to intellectual property claims.

It was five years ago that the Colombia-based International Center for Tropical Agriculture (CIAT, a CGIAR center), with support from FAO, filed an official challenge of the now infamous Enola bean patent at the US-PTO in Washington.

Bean Biopiracy: The Enola bean patent case holds a special place in the “biopiracy hall of shame” because the owner of the patent, the president of a Colorado-based seed company, Larry Proctor, won his patent on a yellow bean variety of Mexican origin. US patent number

5,894,079 was issued April 13, 1999. (Proctor bought a bag of commercial beans in Mexico, planted them in Colorado [US], and did several years of selection.) Not long after, armed with both a US patent and plant breeders' rights certificate, Proctor charged that Mexican farmers were infringing his monopoly by selling yellow beans in the USA. Shipments of yellow beans were stopped at the Mexico/US border, and Mexican farmers lost lucrative markets. Proctor also filed lawsuits against seed companies and farmers in the USA, charging that they infringed his monopoly rights for selling or growing yellow beans from Mexico.

Not-So-Final Rejection: On April 14, 2005 the US-PTO released its "final rejection" – a 26-page decision in which the PTO examiner explains her decision to cancel or reject all of the patent's 64 claims. But wait—not so fast! The PTO bends over backwards to give the patent holder the last word. Proctor was given a six-month period to prepare and file a request to extend the re-examination period. On 14 October 2005 Proctor filed his request and won a 3-month reprieve. ETC Group learned today that the US-PTO has just issued another "final" rejection in response to Proctor's amendments. But, it's still not final! Proctor could file for one more extension – or take the case to a higher board of appeals.

ETC Group does not know when the US-PTO will issue its truly final decision. We do know that expert bean breeders and geneticists have offered unambiguous findings that the Enola bean is not new or unique.

In 2003 geneticists performed "genetic fingerprinting" of Proctor's patented yellow bean and found that his claim of novelty was spurious – the patented Enola bean is, not surprisingly, identical to a pre-existing Mexican cultivar.¹ "We conclude that Enola is neither a novel nor non-obvious derivative from a Mexican yellow bean cultivar, probably 'Azufrado Peruano 87.'²

If the patent is ultimately rejected, it will be a hollow victory because hundreds of Mexican and US farmers who suffered damages as a result of the unjust monopoly will not be compensated for their losses. Patent law has no mechanism to compensate those who have been victimized by patent abuses.

ETC Group will continue to monitor the patent challenge, and we will report on the final outcome. But don't hold your breath!

The Enola Bean Patent Reexamination Saga

13 April 1999: Proctor wins US Patent No. 5,894,079, "field bean cultivar named enola"

15 January 2000: ETC Group denounces the enola bean patent as technically invalid and morally unacceptable <http://www.etcgroup.org/article.asp?newsid=31>

20 December 2000: Request for Reexamination of US patent 5,894,079 (issued 13 April 1999) filed by CIAT <http://www.etcgroup.org/article.asp?newsid=96>

30 November 2001: Proctor sues 16 small bean seed companies and farmers in Colorado for infringing his patent <http://www.etcgroup.org/article.asp?newsid=282>

02 December 2003: USPTO's reexamination results in "Non Final" Rejection of Patent

02 June 2004: Proctor submits 400+ page amendment to "Non Final" Rejection

14 April 2005: USPTO issues "Final Rejection" of Patent

14 October 2005: Proctor submits Request for Continued Examination of Patent

21 December 2005: USPTO issues another "Final Rejection" of Patent

2006 and beyond: ???

¹ L. Pallottini, J. Kami, G. Barcaccia, P. Gepts, *The Genetic Identity of a Patented Yellow Bean*, a paper presented at the American Society of Agronomy Annual Meeting, Denver, November 2-5, 2003.

² *Ibid.* The official results were published in the May/June 2004 issue of *Crop Science*, Pallottini et al., “The Genetic Anatomy of a Patented Yellow Bean,” *Crop Science*, 44:968–977 (2004).